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EXAMINER

HARRISON, JESSICA

ART UNIT

PAPER NUMBER

3714

DATE MAILED: 06/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/472,042

Applicant(s)

Swanberg et al.

Examiner

J. Harrison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 2, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-50 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

Applicant's amendment of April 2, 2002 is acknowledged. Claim 15 has been canceled. Claims 5, 11, 14, 17, 18, 22 and 27 have been amended. Claims 35 - 50 have been added. An action on the merits follows.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 18, "said computer including an Internet connection" is vague: it is assumed said computer includes means for providing an Internet connection. Furthermore, there are two computer programs defined in claim 18 which are not clearly delineated, thus rendering the references to "said program" in the dependent claims indefinite in as much as it is not known which of the two distinct programs are further defined.

It is also noted that, in general, many of applicants claims attempt to further define structure by functional or descriptive language. Applicant is reminded if his intention is to describe a structure by function, means for performing the function are necessary for the function

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to be limiting to the structure. For example, claim 13 appears entirely functional and does not further limit any structure of the system. A means for comparison needs to be established for a comparison step to be limiting to the system.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 1-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Peppel ('216).

The rejection contained in the first office action is maintained and repeated hereinbelow.

Note that Peppel encompasses a wide range of digital media, including data cards which the examiner reads to encompass well known smart cards. Peppel encompasses both network interactivity as well as PC based interaction/play, security features/aspects, interaction with a database, data storage on card, themed interaction and application to sports simulation gaming. The reference is deemed to meet the claims as broadly claimed. See the response to arguments section below for further elaboration on the Examiner's reading/interpretation of the Peppel reference.

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***Claim Rejections - 35 USC § 102***

Claims 38 - 50 are rejected under 35 U.S.C. 102(e) as being anticipated by Peppel '261 or Sehr '292.

Peppel's card incorporates a security algorithm (password, lock and key, copy protection) and game playing identification data(pointers to external data 44, at least) which are utilized in accessing the online database/game aspects of the system. Included in Peppel is a header ID which uniquely identifies the card, and there is storage capacity in the card to permit storage from outside the card, via either local or remote computer system. Clearly usage of the password protection scheme and "lock and key" data verifies users of the card.

Sehr teaches a card system and method that encompasses collectable cards and card-based privileges such as access to online services. Sehr utilizes a smart card and incorporates security information, as claimed. See Fig 2 and corresponding descriptions, at least and 5:43-11:60.

Sehr's system databases include an audit trail of each cards usage. The references are deemed to meet the claims as broadly claimed.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peppel in view of Sehr.

Peppel's data card lacks the claimed processor. While no processing functions are claimed, and Peppel's data card encompasses all functions that are claimed, Peppel does not explicitly state that his data card has a processor. In an analogous trading card system, Sehr clearly discloses the use of a smart card which includes a microprocessor, as he clearly states that his smart card has processing capabilities. It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize data cards with processing capabilities in Peppel's system, as they were well known types of data cards and are advantageously suggested in an analogous system. Clearly use of such a card would enhance the objectives of the Peppel card.

### ***Response to Arguments***

Applicant's arguments filed April 2, 2002 have been fully considered but they are not persuasive.

No amendment is seen to claim 18(or dependent claims) which resolves the examiners 112 second paragraph concerns. The rejection is maintained.

Regarding the examiners notation regarding claim 13 and the excessive functional language adopted by applicant throughout the claims, no question of statutory subject matter was

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raised. The broad sweeping statement that a computer is capable of the functions does not render the functional language limiting to the claims. Again, if it is applicant's intention is to describe a structure by function, means for performing the function are necessary for the function to be limiting to the structure. Applicant is referenced to 35 USC 112, 6th para, and corresponding sections of MPEP 2100 for explanation. The examiner has not stated these claims are not statutory. The examiner has not stated these claims are indefinite, nor has the examiner rejected these claims. The examiner is merely noting that function, without means for performing the function, is not limiting and can not serve to define patentability of identical structure in the prior art.

Next, Applicant begins his attack on the Examiner's position noting that "In reviewing the Peppel reference, there is no indication that any game playing occurs which is interactive with the 'smart' card". Note that in addition to having games and puzzle data contained on Peppel's card, there are numerous teachings of game/card interactivity. See 11:1-21 at least. "The use of a secure physical 'smart' card for gaining access to the game, and storing various data related to the play of the game, is totally absent from the Peppel reference". Again, at least the passage quoted above shows this. Applicant is reminded he must consider the entirety of the Peppel reference for what it teaches, not just selective sections. Further, Applicant's own argument loses merit when, in the next paragraph of applicant's submission, on page 10 of the remarks, last two paragraphs, Applicant quotes a passage of Peppel from col's 13-14 which also illustrates where Peppel teaches interactive play, security, and game information storage on Peppel's card. This

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recognition of the abilities of Peppel voids any argument to the contrary. Peppel's ETC is an integral part of advancing in the Peppel games.

Applicant's final argument revolves around applicant's contention that Peppel does not include a 'smart' card, and that applicant claims a 'smart' card, therefore Peppel does not anticipate. In response, first it is noted that while applicant claims include the adjective 'smart', no processing is claimed. Further, reviewing applicants disclosure, applicant states he uses a 'smart' card which has a processor, and that this card stores information, transfers security information, stores security routines that are read out, stores performance information, and stores card ID and card type information. No disclosure is seen of applicant's card actual performing any data processing on the card. Peppel's data card also accomplishes these functions. Therefore, Peppel's data card is as smart as Applicant's 'smart' card, and the examiner remains unpersuaded as to patentability.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The additional art is related to other types of electronic trading card games/systems and sports simulative games. It is urged that applicant fully consider all art of record in preparing a response to the rejections.



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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Harrison whose telephone number is (703) 308-2217.


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jjh

June 13, 2002



JESSICA HARRISON  
PRIMARY EXAMINER